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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,804	06/07/2001	James Terry Dollens		5344

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EXAMINER

LAFORGIA, CHRISTIAN A

ART UNIT PAPER NUMBER

2131

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,804

Applicant(s)

DOLLENS, JAMES TERRY

Examiner

Christian La Forgia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-40, 42-57 is/are rejected.
- 7) ☒ Claim(s) 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/6/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01 April 2005 has been entered.
2. Claims 1-57 have been presented for examination.
3. Claims 1-28 have been cancelled without prejudice as per Applicant's request.

Response to Arguments

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies, such as inserting a system identifier into an object or extracting the system identifier to compare the extracted identifier to a stored identifier, are not recited in the all of the independent claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
5. Applicant's arguments with respect to claims 29-57 have been considered but are moot in view of the new ground(s) of rejection.
6. See further rejections that follow.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 29-35 and 52-57 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,788,800 to Carr et al., hereinafter Carr.

9. As per claims 29 and 52, Carr discloses a method for authorizing execution of an object on a computer system comprising:

(a) selecting an object on the computer system (column 1, lines 32-38, column 2, lines 20-26);

(b) determining the presence or absence of a first identifier in a steganographic zone of the object, wherein the first identifier and the stenographic zone of the object are formed by the computer system (column 1, lines 49-55, column 4, lines 48-59, i.e. “decodes security data steganographically embedded into the product,” “detect the watermark...[and] security data”); and

(c) comparing the first identifier in the steganographic zone to a second identifier, wherein the object is executed if the first identifier matches the second identifier (column 4, line 54 to column 5, line 46, “compares the computed security data with the decoded security data”).

10. Regarding claims 30, 37, 45, and 53, Carr teaches wherein the identifiers comprise a sequence of fields for creating a unique copy of the object and an ownership token between the object and the system (column 2, lines 45-65, column 6, lines 28-46, i.e. serial number, product code, licensing, etc.).

11. Regarding claims 31, 38, and 46, Carr discloses wherein the second identifier is stored on the system (column 4, lines 35-47, i.e. "serial number in plain view on the product").

12. Regarding claims 32, 39, 47, and 54, Carr discloses wherein the second identifier is stored on an external data storage structure (column 4, lines 35-47, i.e. "serial number in plain view on...its packaging or documentation").

13. Regarding claims 33, 41, and 49, Carr teaches wherein the first identifier is extracted from the steganographic zone of the object (column 4, lines 47-59).

14. With regards to claims 34, 42, 50, and 56, Carr teaches wherein the external data storage device comprises data for extracting the first identifier (column 4, lines 37-46, i.e. "present the product for scanning").

15. Regarding claims 35, 43, 51, and 57, Carr discloses wherein the system identifier is encrypted (column 2, lines 56-65).

Claim Rejections - 35 USC § 103

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

17. Claims 36-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr in view of U.S. Patent No. 5,919,257 to Trostle, hereinafter Trostle.

18. As per claims 36 and 44, Carr discloses a method for identifying unauthorized objects on a computer system comprising:

(a) authorizing objects of the computer system by embedding a system identifier into the authorized objects (column 2, line 45 to column 4, line 28);

(b) determining the presence of the system identifier in objects of the computer, wherein objects that are not embedded with the system identifier are unauthorized (column 4, line 30 to column 5, line 46).

19. Carr does not teach isolating unauthorized objects from the computer system.

20. Trostle discloses isolating unauthorized objects from the computer system (column 7, lines 28-42).

21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to isolate the unauthorized objects from the computer system, since Trostle states at column 7, lines 28-42 that such a modification would isolate objects that have unauthorized changes, which may be potentially malicious code.

22. Regarding claims 40, 48, and 55, Carr discloses wherein the system identifier is embedded in a steganographic zone of the object (column 1, lines 38-49, i.e. "steganographically embeds security data into the data").

Claim Objections

23. Claim 41 is objected to because of the following informalities: It is unclear what is being extracted from the steganographic zone. For the sake of examination, the Examiner will interpret claim 41 to be comparable to claims 33 and 49.

24. Appropriate correction is required.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

26. The following patents are cited to further show the state of the art with respect to comparing identifiers, such as:

United States Patent No. 6,161,115 to Ohanian, which is cited to show media editing system with improved effect management.

United States Patent No. 6,718,446 to Peters et al., which is cited to show storage media with benchmark representative of data originally stored.

United States Patent No. 6,247,133 to Palage et al., which is cited to show authenticating electronic documents on a computer network.

United States Patent Application Publication No. 2002/0055942 to Reynolds, which is cited to show creating, verifying, managing, and using original digital files.

United States Patent Application Publication No. 2002/0177993 to Veditz et al., which is cited to show embedded local descriptors within data objects.

United States Patent Application Publication No. 2005/0069171 to Rhoads et al., which is cited to show embedded data in objects used to authenticate the object.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792.


The examiner can normally be reached on Monday thru Thursday 7-5.

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28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Clf


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